

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 12, 2005. Claims 1-5, 7-15, 17-25, 27-34, and 36-39 were pending in the Application. The Examiner rejects Claims 1-5, 7-15, 17-25, 27-34, and 36-39. Applicants respectfully request reconsideration in light of the comments below and favorable action in this case.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 7-11, 17-21, 27-31, and 36-39 include patentable limitations not taught or suggested by the proposed Helm-Padovani combination

The Examiner rejects Claims 1, 7-11, 17-21, 27-31, and 36-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,719,871 which issued to Helm et al. ("Helm") in view of U.S. Patent No. 6,151,502, which issued to Padovani et al. ("Padovani"). Applicants traverse and submit that even if the above combination is proper, which Applicants do not concede, the above combination cannot render obvious the claimed embodiments because they fail to disclose, teach or suggest each and every limitation of the claimed embodiments. In order to make obvious Applicants' claimed invention, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent Claim 1 recites, among other limitations a base transceiver station (BTS) operable to monitor metrics associated with a "mobile unit" and a "second mobile unit." Independent Claim 11 recites a method and Claim 21 recites wireless communications software that recites, among other limitations: "receiving information from a mobile unit using a wireless link ...", "determining a metric associated with the wireless link" and "monitoring a metric associated with a second wireless link with a second mobile unit." Similarly, Independent Claim 31 recites a base transceiver station that includes, among other limitations, "means for receiving information from a mobile unit via a wireless link with a mobile unit" and "means for monitoring a metric with a second wireless link with a second mobile unit."

The Examiner has indicated that “Helm does not disclose the processor is operable to monitor or determine a metric associated with the second wireless link, between the wireless interface and a second mobile unit, has exceeded a predetermined threshold, register with a selection group, and instruct the wireless interface to being receiving information from the second mobile unit.” See Office Action, at Page 3. The Examiner cites to Padovani as disclosing the monitoring and determining a metric associated with the second wireless link between the wireless interface and the second mobile unit. Applicants submit that Padovani fails to disclose, teach or suggest monitoring a metric associated with a wireless link between a wireless interface and a second mobile unit.

Padovani relates to a system and method for performing hand-off operations in a wireless communication system. Col. 1, lines 7-10. The teachings of Padovani are limited to a single “mobile station 2” that “measures the strength of pilot signals of base stations 4.” Col. 5, line 65. The pilot signal strength information is utilized by a hand-off control processor 20 to determine which base stations will communicate with the mobile station 2. See Col. 7, lines 14. Accordingly, Padovani is clearly limited to teaching measurement of pilot signals with respect to only a single mobile unit. This is especially true since Padovani relates to a hand-off operation, that is, the determination of which base stations should be in communication with a particular mobile station at a particular time.

For at least these reasons, Applicants submit that neither Helm nor Padovani alone or in combination teaches each and every limitation of Independent Claims 1, 11, 21 and 31. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection, and full allowance of Claims 1, 11, 21 and 31 and their respective dependent claims.

Claims 1, 8-11, 18-21, 28-31, and 37-39 include patentable limitations not taught or suggested by the proposed Derango-Padovani combination

The Examiner rejects Claims 1, 8-11, 18-21, 28-31, and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,867,491 which issued to Derango et al. (“Derango”) in view of Padovani. Applicants traverse.

Similar to the rejection above, the Examiner indicates that Derango does not disclose the monitoring of a second mobile unit and cites to Padovani for teaching the pilot strength measurement at a second mobile unit. For the reasons recited above, Applicants submit that

Padovani fails to teach pilot strength measurement/monitoring at a second mobile unit. Instead, Padovani is limited to teaching the measurement/monitoring of a single mobile unit. Applicants submit that neither Derango nor Padovani alone or in combination teaches each and every limitation of the claims embodiments of Independent Claims 1, 11, 21 and 31. Applicants thus request reconsideration, withdrawal of the §103 rejections and full allowance of Independent Claims 1, 11, 21 and 31 and Claims 7-10, 17-20, 27-30, and 36-39 which depend therefrom.

Claims 2-5, 12-15, 22-25 and 32-34 include patentable limitations not taught or suggested by the proposed Helm-Padovani-Bomar combination

The Examiner rejects Claims 2-5, 12-15, 22-25 and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Helm and Padovani in view of U.S. Patent No. 6,535,738 which issued to Bomar et al. ("Bomar"). Applicants traverse. Claims 2-5, 12-15, 22-25 and 32-34 depend from Claims that have been placed in condition for allowance. Additionally, Helm, Padovani and Bomar alone or in combination fail to disclose each and every limitation of Claims 2-5, 12-15, 22-25 and 32-34. Accordingly, a rejection under 35 U.S.C. §103 is unsupported and Applicants request the Examiner to withdraw the rejection of Claims 2-5, 12-15, 22-25 and 32-34.

Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a horizontal line extending to the right.

Kurt M. Pankratz
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